



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,646	12/10/2001	Takehiko Shioda	Q67593	2221

65565 7590 05/21/2007
SUGHRUE-265550
2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/006,646

Applicant(s)

SHIODA ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17, 18, 29-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16, 19-28, and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17, 18, 29-34, and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-14, 17, 18, 29-34 and 36-41 in the reply filed on 2/16/2007 is acknowledged.

Claim Objections

2. **Claim 41 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.**
Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim mixes statutory classes and fails the infringement test in MPEP 608.01(n) as being an improper dependant claim. A CD-ROM having instructions to perform the method step would infringe claim 41, but not the method claim since the CD-ROM itself only stores steps, it does not perform them. Mere possession of such a CD-ROM would infringe claim 41, but not the associated method claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 6, 12, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 6, this claim recites the limitation “wherein the provider...is a paper medium”. It is unclear how the provider can be made out of paper. For the purpose of applying prior art, Examiner considers this to mean the provider is capable of outputting paper.

Regarding claim 12, this claim recites the limitation “only the identification number...is input”. The parent claim from which this claim depends recites “inputting the advertisement information”. Limitations from parent claims can’t be changed, only further limited. Claim 12 improperly changes the input information from advertisement information to an identification number.

Regarding claim 29, this claim recites the limitation “guiding a mobile”. This language is unclear. To what does a “mobile” refer? For the purpose of applying art, Examiner considers this to be a mobile device.

Further regarding claim 29, this claim recites the limitation “advertisement object point”. This language is unclear. To what does a “point” refer? For the purpose of applying art, Examiner considers this to be a geographic area identified by the advertisement information.

Further regarding claim 29, this claim recites the limitation “visit data issued by an advertisement object”. This language is unclear. How does an “advertisement

Art Unit: 3622

object” issue “visit data”? For that matter, what is an “advertisement object” and what to what does “visit data” refer?

Further regarding claim 29, this claim recites the limitation “predetermined range containing the advertisement object point”. This language is unclear. Is the range supposed to represent a number range, a value range, or a geographic range? For the purpose of applying art, Examiner considers this to be the area encompassed by a wireless signal.

Regarding claim 30, this claim recites the limitation “guiding in a voice”. This language is unclear. How is guiding supposed to be contained within a voice? For the purpose of applying prior art, Examiner considers this to be audio-guided.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 11-14, 17, 29-34, 36, and 38-41 are rejected under 35

U.S.C. 102(e) as being anticipated by Treyz (U.S. Patent No. 6,587,835). Treyz teaches a wireless advertising system and method that includes all of the limitations recited in the above claims.

Art Unit: 3622

Regarding claims 1, 7, 11, 17, 29, 30, 34, 36, 40, and 41, Treyz teaches an advertisement providing apparatus teaches a transmitter/receiver (Figure 16) for communicating with a user device (Column 23, Lines 8-22) and sending advertisement information to said device (Column 39, Lines 49-62). Treyz also teaches a user device for inputting advertisement information wirelessly, guiding the user to a location based on the advertisement information (the name of the store is included in the advertisement information) (Figures 42-45), and sending a notification signal when the device arrives at a destination (Establishing a link to the local connection is a notification signal) (Column 34, Lines 6-14).

Regarding claims 2-5, 12-14, 31, Treyz teaches wireless communication to receive the advertisement information. For this type of transmission to take place, the user and merchant devices inherently have IP addresses (identification numbers) to be able to communicate. Using these addresses, Treyz establishes the location of user and the merchant and guides the user to the retail establishment (Figure 42). Since the IP addresses of the user and merchant are what is used to guide the mobile unit, that IP address of the merchant is believed to be the only information input to the navigation portion (unit) of the mobile device.

Regarding claim 6, Treyz teaches the portable device as being connectable to a kiosk to print information (Column 53, Lines 55-60).

Regarding claims 8, 9, 32, Treyz teaches a connection being made from a portable user device to a merchant point of sale to engage in a transaction for merchandise (Column 18, Lines 59-67 and Column 19, Lines 1-17).

Regarding claims 33 and 39, Treyz teaches a smart card as being attached to the portable device for the portable device to function properly (Column 18, Lines 51-56).

Regarding claim 38, Treyz teaches providing a bonus for being in close proximity to a merchant (Figure 51, the bonus being that men's suits are half price).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 18 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz (U.S. Patent No. 6,587,835).

Regarding claims 10 and 37, Treyz teaches the portable device as operating within a mall with a plurality of stores (Figure 37). Treyz does not specify charging merchants within the mall for taking part in the wireless advertisement system. Official notice is taken that it is old and well known to charge advertisers for allowing them to advertise their stores and products. Online webpage affiliate programs represent an example of charging an advertiser for traffic to their website that originates from an affiliate site. It would have been obvious to one having ordinary skill in the art at the time the invention was made to charge merchants to be apart of the mall wireless advertising system so the mall would be able to make money on the expenditure.

Regarding claim 18, Treyz teaches a mobile unit as guiding a user to a merchant (Figure 42). Treyz does not specify terminating the guidance system when the notification signal is sent. Official notice is taken that it is old and well-known to close a computer program when it is not in use. This is often done to save computer resources and/or power. It would have been obvious to one having ordinary skill in the art at the time the invention was made to terminate the map guidance software once it is no longer needed in the interest of saving computer resources and power of the portable device.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to wireless advertising and guidance systems.

U.S. Patent No. 6,317,718 to Fano

U.S. Patent No. 6,965,868 to Bednarek

U.S. Patent No. 6,332,127 to Bandera

U.S. Patent No. 6,912,98 to Domnitz

U.S. Pub No. 2005/0227709 to Chang

U.S. Pub No. 2005/0177416 to Linden


U.S. Pub No. 2002/0107027 to O'Neil

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB


JEFFREY D. CARLSON
PRIMARY EXAMINER